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f/k/a EL BANDIDO YANKEE, LLC  
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9 UNITED STATES DISTRICT COURT  
10 NORTHERN DISTRICT OF CALIFORNIA, SAN FRANCISCO DIVISION  
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12 ROAR SPIRITS, LLC, a Delaware limited  
liability company, f/k/a EL BANDIDO  
13 YANKEE, LLC,

14 Plaintiff,

15 vs.  
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17 REBEL WINE CO., LLC, a California  
18 limited liability company,

19 Defendants.  
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Case No.

**COMPLAINT FOR JUDICIAL  
REVIEW**

1 Plaintiff Roar Spirits, LLC, f/k/a El Bandido Yankee, LLC (“Plaintiff”) for its  
2 complaint against defendant Rebel Wine Co., LLC (“Defendant”) alleges as follows:

### 3 **PRELIMINARY STATEMENT**

4 1. On June 30, 2020, Plaintiff filed applications to register the marks EL  
5 BANDIDO YANKEE (“EL BANDIDO YANKEE Mark”) and EL BANDIDO  
6 YANKEE TEQUILA COMPANY BLANCO and design (“Design Mark,”  
7 collectively referred to with the EL BANDIDO YANKEE Mark as the “EL  
8 BANDIDO YANKEE Marks”):



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18 The application for the EL BANDIDO YANKEE Mark was assigned the  
19 Application Serial No. 90028911 (the “’911 Application”); and the Design Mark was  
20 assigned the Application Serial No. 90029117 (the “’917 Application.”) (The ‘911  
21 Application and the ‘917 Application are collectively referred to as the  
22 “Applications.”)

23 2. Defendant manufactures boxed wines and wine-based seltzers that it  
24 sells under the mark BANDIT. While Defendant only sells wines and wine-based  
25 seltzers under the BANDIT mark, that mark is registered for “alcoholic beverages  
26 except beers” in class 33.

27 3. Defendant opposed Plaintiff’s Applications to register the EL  
28 BANDIDO YANKEE Marks. Defendant’s opposition was assigned Opposition No.

1 91268314 (“Opposition”). Defendant’s Opposition was largely based on the fact  
2 that its broad registration for “alcoholic beverages except beers” in class 33  
3 encompasses tequilas within its scope. Based on this, Defendant Opposer asked the  
4 TTAB to disregard the numerous and obvious dissimilarities between the BANDIT  
5 and EL BANDIDO YANKEE Marks, the fact that they are used on widely disparate  
6 alcoholic products (tequila v. boxed wines), and the fact that, as these marks are  
7 used in the real world, there is ***no chance*** of any consumer being confused between  
8 these marks, as evidenced by the lack of actual confusion, despite the marks having  
9 co-existed for a significant period of time. This is obvious based even on a cursory  
10 review of the products:



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21 4. In any event, the fact that BANDIT’S broad trademark registration  
22 includes within its scope tequilas is insufficient on its own to sustain the opposition,  
23 and the TTAB erred in sustaining the Opposition on this basis. There are thirteen  
24 separate factors that the Board was required to consider in adjudicating whether  
25 Plaintiff’s marks could be registered. Contrary to the findings of the TTAB, the  
26 majority of these factors weighed against Defendant’s opposition. As a result, the  
27 TTAB erred in sustaining Defendant’s Opposition and denying Plaintiff’s  
28 registration of the marks.

**PARTIES**

5. Plaintiff is a Delaware limited liability company duly organized and existing under the laws of the state of Delaware with a place of business at 211 N. Williamsburg Drive, Suite A, Bloomington Illinois, 61704.

6. On information and belief, Defendant is a limited liability company organized and existing under the laws of California, having a place of business at 100 St. Helena Hwy South, St. Helena, California, 94574.

**JURISDICTION AND VENUE**

7. The Court has subject matter jurisdiction over this action pursuant to 15 U.S.C. §§1071(b)(1) and (4).

8. This Court has personal jurisdiction over Defendant because Defendant is a California limited liability corporation with its principal place of business located in the County of Napa.

9. Venue in this district is proper pursuant to 28 U.S.C. § 1391(b)(1) because the Defendant resides in the County of Napa.

**FACTS COMMON TO ALL CLAIMS**

**A. The Trademarks at Issue In This Proceeding**

10. The trademarks which are the subject of Plaintiff's applications are:
- The EL BANDIDO YANKEE TEQUILA COMPANY BLANCO and Design Mark:



1 for “Blue distilled agave tequilana weber liquor” in Class 33.

- 2 • The EL BANDIDO YANKEE mark for “Distilled blue agave liquor” in
- 3 Class 33.

4 11. Defendant is the owner of the registered word mark BANDIT for

5 “alcoholic beverages except beers”<sup>1</sup> in Class 33.

6 **B. El Bandido Yankee Tequilas**

7 12. Plaintiff Roar Spirits, LLC, which was previously known as El Bandido

8 Yankee Tequila Company, LLC, was co-founded by two former professional

9 athletes, Jim Bob Morris, a former NFL player who played for the Green Bay

10 Packers, and Chris Chelios, a former NHL player who played for the Chicago

11 Blackhawks.

12 13. The name “El Bandido Yankee” is a reference to a line from the movie

13 Butch Cassidy and the Sundance Kid in which a character in the film says “Some

14 say it’s the Bolivian Bandits, and some say it’s the Bandidos Yankees.” At the time

15 that El Bandido Yankee came up with its name, it was not aware of Defendant’s

16 Bandit’s wine products.

17 14. Wines and tequilas are altogether different alcohol products. Tequila is

18 a distilled spirit liquor, regulated by the CRT in Mexico, that is made from the blue

19 weber agave plant (agave tequilana), using a double (and sometimes triple)

20 distillation process, to create a liquor with a minimum alcohol content to qualify as

21 Tequila in the US of 40% alcohol by volume (“ABV”). In contrast, wines are

22 produced by fermenting grapes, and no distillation process is employed in the

23 manufacture of wines. Additionally, wines have a far lower alcohol content than

24 distilled liquors, typically ranging between 11% and 15% ABV.”

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26 <sup>1</sup> As is discussed in detail below, while Opposer’s BANDIT mark is registered for

27 “alcoholic beverages except beers,” the undisputed evidence is that Opposer has *never* used this

28 mark for any products other than wines or wine-based hard seltzers, and, in particular, has *never* used this mark for tequila.

1        15. El Bandido Yankee tequilas are manufactured by a single distillery in  
2 Jalisco, Mexico. Plaintiff does not, and never has, produced, sold or distributed any  
3 wine products, and has no intention of producing, selling or distributing any wine  
4 products in the future. Plaintiff also does not and never has produced, sold or  
5 distributed any hard seltzer products (whether tequila-based, wine-based or  
6 otherwise), and has no intention of producing, selling or distributing any tequila-  
7 based, wine-based, or other types of hard seltzer products of any kind in the future.

8 **C. Plaintiff's Product Packaging**

9        16. Plaintiff bottles its tequilas in distinctively designed glass bottles, with  
10 El Bandido Yankee's name and one of El Bandido Yankee's designs on such  
11 bottles, including the words "El Bandido Yankee Tequila Company" on the label. A  
12 750 ml bottle of El Bandido Yankee tequila, is depicted adjacent to a one liter box  
13 of Bandit wine in the following photograph:



23        17. Plaintiff does not sell or intend to sell any of its tequila products in  
24 tetra-pak boxes or boxes of any other kind and also does not sell any tequila or  
25 tequila products in cans. Specifically, Plaintiff does not produce or sell any kinds of  
26 "hard seltzer" products, including, without limitation, any tequila-based hard  
27 seltzers, in cans or otherwise.

28        18. Plaintiff always includes the words "El" and "Yankee" alongside the



word “Bandido” and typically includes “Tequila Company” on its product packaging. El Bandido Yankee never refers to itself or its product on its product packaging as simply “El Bandido,” or “Bandido” without the inclusion of the words “El” and “Yankee.” Additionally, all El Bandido Yankee tequila bottles always include its design on its bottles with the El Bandido Yankee product name, consisting of a stylized image of a masked figure (“El Bandido”) wearing a traditional cowboy hat (“Yankee”).

**D. Plaintiff’s Target Market**

19. The target market for Plaintiff’s El Bandido Yankee tequila products is college Educated 27-54 year olds, with household income over \$85,000 per year, who appreciate high quality products with transparency in ingredients and production. Plaintiff’s marketing message is around creating elevated experiences, typically within nightlife settings, dinners or events along with a high connection to organized and professional sports – NFL, NHL, NASCAR, to name a few, with events the brand has sponsored. Plaintiff does not market its products to campers, hikers or other outdoors enthusiasts. Indeed, given that El Bandido Yankee tequilas are only sold in large, 750 ml glass bottles, this product is particularly ill-suited to take on a camping or hiking trip.

**E. Plaintiff’s Marketing Efforts and Strategy**

20. Consistent with its co-founders being former professional athletes, a key part of Plaintiff’s marketing strategy for its El Bandido Yankee tequilas is to enter into numerous sponsorship deals with various professional sporting events and athletes. For example, Plaintiff has engaged in the following sports-related marketing activities to promote its El Bandido Yankee tequilas:

- Hula Bowl, January, 2022. Plaintiff hosted tailgating parties, concessions vendor, a barbecue with Blues Hog, and other marketing events, at a cost of approximately \$125,000.
- Busch Clash, Memorial Coliseum, Los Angeles, the kickoff event for

1 Nascar. Plaintiff threw a Busch Clash party at the bar at the top of the  
2 Hotel Indigo in downtown LA, and entertained key account holders for  
3 the races on Sunday of that weekend, at an approximate cost of \$5,000.

- 4 • Irwindale Late Model races – Southwest Series at Irwindale  
5 Speedway. Plaintiff hosted all racing pole awards, including full El  
6 Bandido Yankee signage and tasting at the race track on the Saturday  
7 before the Busch Clash, at an approximate cost of \$2,000.
- 8 • Daytona 500 + Speedweeks Events – El Bandido Yankee sponsorship  
9 for Truck, Xfinity, Cup races; tasting activity; sponsorship of the Pit  
10 Road Pickers band for 2 concerts during speed weeks, at an  
11 approximate cost of \$25,000.
- 12 • Plaintiff places El Bandido Yankee advertising on SiriusXM Nascar  
13 Racing Channel 90 – Front Stretch show featuring Pat Patterson, and is  
14 an official sponsor of the show. The advertising cost on this show for  
15 2022 is \$25,000.
- 16 • Plaintiff sponsors Extreme Skater Brittan Morris, who participates in  
17 Ice Cross, an extreme winter sporting event, at an annual cost of  
18 \$2,000.
- 19 • Plaintiff sponsors MMA Fighter Dustin Jacoby, at an approximate  
20 annual cost of \$2,000.
- 21 • Plaintiff promotes its El Bandido Yankee tequilas at all Chicago  
22 Blackhawks hockey games via WGN radio, at an approximate annual  
23 cost of \$15,000.
- 24 • Plaintiff has El Bandido Yankee concession stations throughout Van  
25 Andel Arena in Grand Rapids, Michigan for the Grand Rapids Griffins  
26 of the AHL, at an approximate annual cost of \$20,000.
- 27 • Plaintiff participated as an El Bandido Yankee vendor during the BBQ  
28 contest at the Big 12 Basketball Championship in Kansas City,



1 Missouri at an approximate cost of \$10,000.

- 2 • Plaintiff has promoted its El Bandido Yankee tequilas at numerous
- 3 Rodeo events, through sponsorships and activations
- 4 • Plaintiff promoted its El Bandido Yankee tequilas at the Palm Beach
- 5 Boat & Yacht Show, at an approximate cost of \$17,000.
- 6 • Additionally, Plaintiff maintains suites with the Kansas City Chiefs,
- 7 Green Bay Packers, Chicago Bears and Kansas University, all for
- 8 promotional purposes.

9 21. In addition to marketing its products through the sponsorship of  
10 sporting events, venues and athletes, Plaintiff also engages in conventional  
11 marketing of its El Bandido Yankee tequilas, such as advertising in magazines,  
12 attending trade shows, advertising on the internet and advertising through social  
13 media. Plaintiff's sponsorship of sporting events, venues and athletes makes up  
14 approximately 30% of its total annual marketing expenditures.

15 **F. El Bandido Yankee Tequila Price Point**

16 22. The per bottle price which Plaintiff charges its wholesale distributors  
17 for El Bandido Yankee Tequilas ranges from \$19-24, depending on the state and  
18 expression of tequila. While both wholesalers and retailers are entitled to sell these  
19 products at whatever prices they see fit, Plaintiff recommends that its wholesale  
20 distributors sell El Bandido Yankee tequila to their retail customers for \$25-39 per  
21 bottle depending on price level and expression, and that retailers who sell El  
22 Bandido Yankee tequila to consumers by the bottle charge a suggested retail price of  
23 \$39-44 per bottle. In general, El Bandido Yankee tequila is sold to end user  
24 consumers at the price range of between approximately \$39 and approximately \$50  
25 per 750 ml. bottle. This is a significantly higher price point than the Bandit boxed  
26 wine products, which are sold at the retail price ranges of \$7-\$10 per 1 liter box and  
27 \$4-\$5 per 500 ml box.

1 **G. El Bandido Yankee Product Distribution**

2 23. Plaintiff sells its El Bandido Yankee tequila products to licensed  
3 distributors, who then, in turn, sell those products on a wholesale basis to retail  
4 outlets, such as retail stores and bars and restaurants, who then sell the El Bandido  
5 Yankee product to the end user consumers. El Bandido Yankee tequilas are sold by  
6 numerous large chain store retailers, such as, for example, BevMo, Total Wine and  
7 Jewel-Osco as well as by numerous independent, non-chain retail stores. For  
8 example, in the Chicago area, El Bandido Yankee tequilas are sold at Garfield's  
9 Liquors and Liquor Barn, which, on information and belief, do not sell Bandit boxed  
10 wines.

11 24. El Bandido Yankee tequilas are also sold in numerous restaurants and  
12 bars. Of the approximately 1000 licensed accounts selling El Bandido Yankee in  
13 Illinois, approximately 50% of the accounts are "on-premise" bars and restaurants  
14 that generate 50% of El Bandido's revenue. For example, El Bandido Yankee  
15 tequilas are served at Chicago Cut Steakhouse, Gibson's Steakhouse and Tao as  
16 well as at the Fat Rosie's restaurants in the Chicago area. On information and  
17 belief, none of these restaurants serve Bandit Wines.<sup>2</sup>

18 25. Additionally, unlike Bandit Wines, El Bandido Yankee tequilas are not  
19 sold in any self-standing Seven-Eleven type convenience stores and are also not sold  
20 in any gas station-affiliated convenience stores, such as the Extra Mile convenience  
21 stores located at many Chevron gas stations. On information and belief, neither are  
22 El Bandido Yankee tequilas sold by CVS, Rite-Aid or any other similar large  
23 drugstore chains.

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26 <sup>2</sup> Based the "Wine Locator" search tool maintained on the Banditwines.com website,  
27 Bandit Wines appear to be served at very few restaurants, and virtually no "high end" restaurants  
28 such as Chicago Cut Steakhouse or Tao and "Taco and Tequila" restaurants such as Fat Rosie's  
that serve El Bandido Yankee tequila.

1 **H. Retail Displays of Liquors Such as El Bandido Yankee Tequilas as**  
 2 **Compared to Wines Such as Bandit**

3 26. In the retail setting, liquors such as, for example, tequila, gin, vodka  
 4 and whiskey, are generally displayed separately from both wines and beers in retail  
 5 stores. Depending on the size of the store, liquors are generally displayed for sale  
 6 on different shelves from both wines and beers and are often displayed in different  
 7 aisles or different sections of the store altogether.

8 27. Similarly, on-line retailers of alcohol products typically have liquors  
 9 listed in a different category on their websites from both wines and beers. For  
 10 example, the home page of the Bevmo.com website has different drop-down menus  
 11 for “Wine,” “Spirits,” “Beer and Hard Seltzer,” and other product categories, to  
 12 enable customers to search for these various product types by category.

13 **I. Rebel Wines’ Bandit Wine Products**

14 28. Defendant uses the BANDIT mark to sell a line of boxed wine products  
 15 and wine-based hard seltzers. Defendant affirmatively markets its boxed Bandit  
 16 wines products to campers, hikers and outdoor enthusiasts. Indeed, the home page  
 17 of Defendant’s website located at [www.banditwines.com](http://www.banditwines.com) recites:

18 We love wine and we love to explore beautiful landscapes,  
 19 so in 2003 we created Bandit. This light-weight container  
 20 is adventure-ready, keeps our wine fresh and delicious,  
 21 and uses natural resources responsibly. From dinner  
 around the campfire to back-packing on the Pacific Crest  
 Trail, Bandit is ready for wherever the spirit of adventure  
 leads you. Live well and go explore!

22 In this vein, the home page of the Bandit Wines website depicts a backpacker with a  
 23 Bandit Wine box in the packet of his or her backpack (among other images of  
 24 hikers, campers, and outdoor enthusiasts enjoying Defendant’s Bandit boxed wine  
 25 products):



29. On information and belief, Defendant has only used the BANDIT mark to sell wines and wine-based hard seltzers, has never used the mark for tequilas or any other liquors, and has no intention of ever doing so. Defendant's Bandit market is registered for a broad range of products (all alcoholic beverages except beers), despite Defendant only actually using that mark, and only actually having the intention of using that mark, on a very small subset of such products (wines and wine-based seltzers).

**J. Defendant's Contrary Positions Taken in Other Proceedings With Respect to the Similarity, or Lack Thereof, of the Marks at Issue**

30. In a previous TTAB proceeding, Defendant sought the cancellation of a beer maker's MASKED BANDIT trademark. When presented with evidence in response to that proceeding of the marks BANDOLERO and LA BANDALERA for tequila, Opposer took the position that the BANDOLERO and LA BANDALERA marks "are not relevant to this case as those are marks distinct in appearance and sound." The marks Bandalero and La Bandalera are similar sounding to "Bandido" and, like Bandido, mean "Bandit." Defendant's contention in that case that "those are marks distinct in appearance and sound" constitutes strong evidence, if not a binding judicial admission, that, contrary to Defendant's claim in the TTAB proceedings below, the "El Bandido" in the EL BANDIDO YANKEE marks is similarly distinct in appearance and sound from Defendant's BANDIT mark. In light of these admissions, the TTAB erred in finding the marks to be similar and denying Plaintiff's registration of the EL BANDIDO YANKEE marks on that basis.

31. Similarly, in another case, Defendant secured the assignment to itself of the mark EL BANDIDO NEGRO for “alcoholic beverages, namely, tequila.” Defendant failed to file a section 8 declaration, resulting in the cancellation of the EL BANDIDO NEGRO mark. Opposer’s abandonment of this mark evidences the dissimilarity of the EL BANDIDO NEGRO mark for tequila and the BANDIT mark, and, by extension, the dissimilarity of the EL BANDIDO YANKEE marks for tequila and the BANDIT mark.

**K. Numerous Other Third Parties Use the Term Bandit or Variations Thereof on Food and Beverage Related Products and Services**

32. Defendant is not the only party to use the BANDIT mark for its products. To the contrary, numerous other entities use the mark Bandit for the sale of various food and beverage-related products and services. These include BURGER BANDIT in International Class 043 (for “Fast-food restaurant services; Restaurant and cafe services; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurants featuring home delivery; Self-service restaurants; Take-out restaurant services”); INCHWORM BANDIT in International Class 33 (for “Alcoholic beverages containing fruit; Alcoholic beverages, namely, tequila, jalapeno, basil, pina, and lime; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Prepared alcoholic cocktail.”); AGAVE BANDIDO in International Class 43 (for “Bar services; Café services; Catering services; Restaurant services; Mobile restaurant services; Pop-up restaurant services”); PIZZA BANDIT in International Class 43 (for “Restaurant and bar services”); LOCOS BANDITOS in International Class 30 (for “Food, namely, tea, tea extracts, tea-based beverages, coffee-based beverages, snack foods in the nature of wheat based snack food, corn based snack food; prepared and packaged meals and food package combinations consisting primarily of pasta or rice”); BANDIDOS TAQUERIA B in International Class 43 (for “Restaurant and bar service, including

1 restaurant carryout and catering services”); BURRITO BANDITO in International  
 2 Class 43 for “Restaurant; Restaurant services”); FORAJIDO (which translates to  
 3 “bandit”, “outlaw” or “fugitive”) in International Class 33 (for “Alcoholic  
 4 beverages, namely, distilled spirits”); BANDITOS CANTINA in International Class  
 5 43 (for “Restaurant, bar and catering services”); SALTY BANDITA in International  
 6 Class 43 (for “Restaurants; restaurant services; restaurant, bar, and catering services;  
 7 restaurant and catering services; catering in fast-food cafeterias”); and BANDIDOS  
 8 in International Class 43 for “Mexican restaurant and bar services.”)

9 33. Indeed, a simple Google search for “bandit alcohol reveals numerous  
 10 types of alcoholic beverages sold under marks which include the use of the term  
 11 “Bandit,” including:

- 12 • Time Bandit vodka
- 13 • Bandit’s Rum
- 14 • Goofy Bandit Espressotini
- 15 • Bandit’s Traditional Moonshine
- 16 • Bandit’s Coffee Moonshine
- 17 • Penguin Bay Blackberry Bandit (blackberry wine)
- 18 • The Bandit – the BX Press Cidery (cider)
- 19 • Bandit Gypsy Hill Brewing (pale ale)
- 20 • Apple Bandit (ciders)
- 21 • Bandit Brewing (beers)
- 22 • Bandit Queen Barrel Aged Peach Sour
- 23 • Barrel Bandit (bourbon)
- 24 • Bandits Coffee, Apple Pie and Oatmeal Cookie Moonshine
- 25 • Westend The Barrel Bandit (wine)
- 26 • Houghton The Bandit Shiraz and Cabernet (wine)

27 **L. The Trademark Trial and Appeal Board Proceedings**

28 34. On March 23, 2021, Defendant filed a Notice of Opposition to



1 Plaintiff's application for the registration of the EL BANDIDO YANKEE marks.  
 2 Defendant's Opposition contends that Plaintiff "is not entitled to register the EL  
 3 BANDIDO Marks and Applicant's Applications should be denied in accordance  
 4 with Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d)."

5 35. Defendant's Opposition is based on the contention that the EL  
 6 BANDIDO YANKEE Marks "are likely to cause confusion, mistake or to deceive  
 7 the public because they are virtually identical to Opposer's BANDIT Mark and the  
 8 goods for which Opposer has registered, and on which Opposer uses Opposer's  
 9 BANDIT Mark are identical, substantially similar or related to the goods identified  
 10 in Applicant's Applications, namely, 'distilled blue agave liquor' and 'blue distilled  
 11 agave tequilana weber liquor,' and said goods are purchased by the same group of  
 12 consumers."

13 36. The proceeding was assigned Opposition No. 91268314.

14 37. Plaintiff, in its Answer, denied Defendant's allegations.

15 38. On July 18, 2023, the Board issued a final decision sustaining the  
 16 opposition filed by Defendant. A true and correct copy of the TTAB's ruling is  
 17 attached as Exhibit 1. That decision is subject to review by this Court under § 21(b)  
 18 of the Federal Trademark Act, 15 U.S.C. § 1071(b).

### 19 **FIRST CLAIM FOR RELIEF**

#### 20 **(Judicial Review of Trademark Trial and Appeal Board Final Decision)**

21 39. Plaintiff realleges and incorporates by reference the allegations in  
 22 paragraphs 1 through 38 as if set forth fully herein.

23 40. As a cause of action and ground for relief against Defendant, Plaintiff  
 24 seeks, in part, a *de novo* judicial review pursuant to § 21(b) of the Federal  
 25 Trademark Act, 15 U.S.C. § 1071(b), of the final decision rendered by the Board in  
 26 *Rebel Wine Co., LLC v. ROAR Spirits, LLC*, Opposition No. 91268314, on the  
 27 following grounds:

28 a. The TTAB erred in finding Plaintiff's and Defendant's

1 respective marks to be similar in their entireties as to appearance, sound,  
2 connotation, and commercial impression to support a likelihood of confusion,  
3 despite the significant dissimilarities between the respective marks, including  
4 significant dissimilarities in connotation and commercial impression, which, alone  
5 requires a finding of dissimilarity between the marks. *Cf Champagne Louis*  
6 *Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed.  
7 Cir. 1998) (affirming dismissal of opposition where the marks “CRISTAL” for  
8 champagne and “CRYSTAL CREEK” for wine evoked different images in the  
9 minds of relevant consumers.).

10           b.     The TTAB erred by failing to accord sufficient weight to the  
11 absence of evidence of actual confusion, erroneously finding such evidence to be  
12 neutral, rather than to weigh against a finding of a likelihood of confusion.

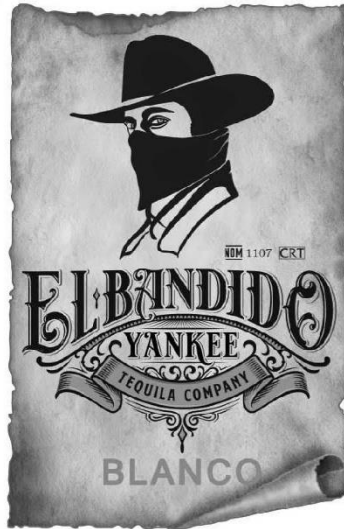
13           c.     Given the evidence of the significantly different price points  
14 between Plaintiff’s high-end tequila products, and Defendant’s inexpensive boxed  
15 wine products, the TTAB erred in finding that the conditions under which and  
16 buyers to whom sales are made (i.e. “Impulse” v. Careful, Sophisticated  
17 Purchasing) did not weigh in favor of a finding of lack of confusion.

18           d.     While correctly finding that Defendant had failed to produce  
19 sufficient evidence to establish the commercial strength of its mark, the TTAB erred  
20 in finding Defendant’s mark to be conceptually strong, given the evidence of  
21 substantial third-party use of such mark, or close variations thereof, on food and  
22 beverage related products and service, including alcoholic beverages.

23           e.     The TTAB erred in finding that Defendant was not estopped  
24 from asserting the similarity of Plaintiff’s El Bandido Yankee marks with its Bandit  
25 mark, after having taken the position in a different proceeding, in which it prevailed,  
26 that the marks BANDOLERO and LA BANDALERA for tequila were “not relevant  
27 to this case as those are marks distinct in appearance and sound.”

28           f.     The TTAB erred in finding that the similarities between

1 Plaintiff's EL BANDIDO YANKEE TEQUILA COMPANY BLANCO design  
2 mark



11  
12 and Defendant's BANDIT word mark weighed in favor of a finding that confusion  
13 is likely.

14 g. The TTAB erred in finding that the similarities between  
15 Plaintiff's EL BANDIDO YANKEE word mark and Defendant's BANDIT word  
16 mark weighed in favor of a finding that confusion is likely.

17 h. As a result of the above-described errors, the TTAB erred in  
18 finding that the weighing of the *DuPont* factors supported a likelihood of confusion  
19 between Plaintiff's and Defendant's respective marks.

20 41. Plaintiff will introduce the following additional evidence to this Court  
21 for *de novo* consideration:

22 a. Survey evidence establishing that there is no likelihood of  
23 confusion between the parties' respective marks.

24 b. Additional evidence establishing the conceptual weakness of  
25 Defendant's BANDIT mark.

26 c. Evidence that Defendant never used the Bandit mark for any  
27 tequila products and has never had any intention of doing so.

28 42. The TTAB's decision was contrary to pertinent law, not supported by

1 substantial evidence and/or was in error in light of the evidence of record with the  
2 TTAB, the allegations in this Complaint, and additional evidence to be submitted by  
3 Plaintiff as set forth above. Therefore, the TTAB's July 18, 2023 decision sustaining  
4 Opposition No. 91268314 should be reversed.

5 **PRAYER FOR RELIEF**

6 WHEREFORE, Plaintiff prays for entry of a judgment ordering that:

7 The Court reverse the final decision of the Board in the Opposition and, in  
8 accordance with § 37 of the Federal Trademark Act, 15 U.S.C. § 1119, direct the  
9 USPTO to register each of Plaintiff's EL BANDIDO YANKEE Marks which are  
10 the subject of the Applications.

11  
12 DATED: September 19, 2023

WOLF, RIFKIN, SHAPIRO,  
SCHULMAN & RABKIN, LLP

13  
14  
15 By: /s/ Eric Levinrad

16 ERIC LEVINRAD

17 Attorneys for Plaintiff ROAR SPIRITS, LLC  
18 f/k/a EL BANDIDO YANKEE, LLC  
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